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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,618	12/18/2000	James M. Barton	TIVO0064	9889

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EXAMINER

MA, JOHNNY

ART UNIT PAPER NUMBER

2614

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Office Action Summary</p>	Application No. 09/740,618	Applicant(s) BARTON, JAMES M.	
	Examiner Johnny Ma	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 5-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/2001</u> . | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
6) <input type="checkbox"/> Other: _____ |
|--|--|

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-4, drawn to providing teasers to entice viewers to view commercial breaks, classified in class 725, subclass 36.
 - II. Claims 5-13, drawn to the display of advertisement before and/or after the play back of recorded content, classified in class 725, subclass 32.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as encouraging viewers to view commercials during a commercial break. See MPEP § 806.05(d).

Invention II has separate utility such as ensuring a number of advertisements are viewed by a user by placing advertisements at the beginning and end playback of recorded content. See MPEP § 806.05(d).

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. The inventions are also distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper. Furthermore, these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Art Unit: 2614

4. During a telephone conversation with Mr. Kirk Wong on 9/21/2004 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-4. Affirmation of this election must be made by applicant in replying to this Office action. Claims 5-13 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 4 is rejected under 35 U.S.C. 102(b) as being anticipated by the Gales Article:

“Creatives find ‘Bookends’ a Solution to Viewer Apathy.”

As to claim 4, note the Gales article that discloses creatives find ‘bookends’ a solution to viewer apathy. The claimed “partitioning the beginning and end of a television advertisement; “wherein each partition is of a predetermined length of time” is met by the bookending comprising splitting of an advertisement into two 15 second spots (see Excedrin Commercial Spot). The claimed “wherein said beginning portion and said end partition contain the more important content designed to get the desired message across to the viewer in the predetermined length of time” is met by wherein the beginning portion of the advertisement conveys a actor with a headache and the end portion signifying the advertised product as the solution to the actor’s headache (see Excedrin Commercial Spot).

Claim Rejections - 35 USC § 103

Art Unit: 2614

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gales Article: "Creatives find 'Bookends' a Solution to Viewer Apathy in further view of Automotive News: Audi Ads focus on technology.

As to claim 1, note the Gales article that discloses creatives find 'bookends' a solution to viewer apathy. The claimed "partitioning the commercial break in a program segment" is met by "[a]n example of bookend commercials is this Excedrin spot by DDB Needham/New York, left and right, in which the actor appears in the first 15-second pod stricken by a headache" and "and then the product's benefit is shown in the second 15 seconds to signify it as being the solution to the actor's headache" (see Excedrin Commercial Spot). The claimed "wherein each partition is of a predetermined length of time" is met by the partitioning of the commercial into 15 second spots (see Excedrin Commercial Spot). The claimed "wherein said beginning and end partitions are carefully authored to provide a teaser to entice the viewer to watch multiple commercials during the break" is met by "[t]he first half is followed by a separate, unrelated commercial so that the viewer has to wait for the second half to see what happens to the sufferer" (see Excedrin Commercial Spot). However the Gales article is silent as to partitioning the beginning and end of the commercial spot. Now note the Audi article that discloses "'bookends' at the beginning and end of commercial breaks" (see Audi, paragraph 2). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to

Art Unit: 2614

modify the Gales bookending with the Audi bookend at the beginning and end of a commercial break for the purpose of encouraging users to watch the entire commercial break in order to view the conclusion of the first 15 second segment.

As to claim 2, the claimed “wherein said teaser is a set of images or logos that indicate a commercial relating to a particular advertiser is present” is met by that discussed in the rejection of claim 1 wherein the video advertisements inherently comprise a set of images.

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gales Article: “Creatives find ‘Bookends’ a Solution to Viewer Apathy in further view of Automotive News: Audi Ads focus on technology and Reichardt et al. (US 2002/0124255 A1).

As to claim 3, the claimed “wherein said teaser is a menu or short sequence of animations designed to catch the viewer’s attention and persuade him to watch the commercial break.” Note the Gales Article discloses the use of bookended advertisement teasers to encourage users to watch a commercial break (see Excedrin Commercial Spot). Now note the Reichardt et al. reference that discloses [t]he advertisements may include any suitable content such as, for example, text, graphics, audio, video, animations, other suitable content, or any suitable content thereof” (Reichardt [0105]). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Gales Article teaser with the Reichardt et al. animations for the purpose of providing teasers that are less costly to produce and to provide an alternate medium for producing such advertising content.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The Hooks et al. reference (US 6,169,542 B1) discloses a method of delivering advertising through an interactive video distribution system.

The Goode et al. reference (US 5,781,227) discloses a method and apparatus for masking the effects of latency in an interactive information distribution system.

The Lonctaux reference (US 6,304,852 B1) discloses a method of communicating computer operation during a wait period.

The Rakavy et al. reference (US 2002/0010775 A1) discloses a method and apparatus for transmitting and displaying information between a remote network and a local computer wherein “[t]he user may have the system present the preview of the Advertisement 50 such as a still image, a short animation sequence, or a sound clip” (Rakavy [0097]).

The Zigmond et al. reference (US 6,698,020 B1) discloses techniques for intelligent video ad insertion.

The Posa et al. reference (US 6,574,416 B1) discloses a picture-based video indexing system.

The Engle et al. reference (US 6,236,801 B1) discloses video replay automation with manual control track editing.

The Dimitrova et al. reference (US 6,100,941) discloses an apparatus and method for locating a commercial disposed within a video data stream wherein “[a] user could be shown the first frame of a commercial and be prompted as to whether he wishes to skip that commercial” (Dimitrova 19:53-55).

The Ford reference (US 6,181,364 B1) discloses a system for filtering content from videos.


The Reynolds et al. reference (US 6,799,327 B1) discloses a program guide with selectable advertisements and pseudo-ads wherein the invention helps to maintain the viewer's interest in the program guide, and allow more advertisements to be viewed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnny Ma whose telephone number is (571) 272-7351. The examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jm


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